

REMARKS

Claims 1-37 are currently pending in the subject Application.

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. (“*Cupps*”) in view of U.S. Patent No. 4,971,406 to Hanson (“*Hanson*”) and U.S. Patent No. 5,895,454 to Harrington (“*Harrington*”).

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter (“*Cotter*”).

Applicant respectfully submits that all of Applicant’s arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections.

I. ART REJECTIONS

A. 35 U.S.C. § 103(a) over Cupps in view of Hanson in further view of Harrington

Pending Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*.

In rejecting Claims 1-11, 13-21, 23-34, 36, and 37 under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* further in view of *Harrington*, the Examiner states “*Cupps discloses the buyer delivery information with the input of their location and **Harrington is relied upon for the delivery time and its importance.***” (30 June 2008 Final Office Action, Page 4). Applicant respectfully submits that, while the Examiner asserts that “Harrington is relied upon for the delivery time and its importance,” Harrington simply fails to disclose, teach, or otherwise suggest “generat[ing] a list of

one or more of the plurality of unaffiliated sellers for at least one of the requested particular food items *according to a comparison of the requested particular food item with the real-time availability information,*” as recited in independent Claim 1.

In particular, the Examiner has not articulated *how* precisely Harrington allegedly performs “*a comparison of the requested particular food item with the real-time availability information.*” Applicant further respectfully submits that the reason that the Examiner has not set forth any evidence that *Harrington* discloses “a comparison of the requested particular food item with the real-time availability information” is simply due to the fact that *Harrington* nowhere discloses such a comparison. Moreover, Applicant respectfully submits that *Cupps* and *Hanson* likewise fail to disclose at least independent Claim 1 limitations regarding to “generate a list of one or more of the plurality of unaffiliated sellers for at least one of the requested particular food items *according to a comparison of the requested particular food item with the real-time availability information.*” Applicant respectfully requests the Examiner to verify the references to *Harrington*, to ensure that some mistake has not been made.

Related to the foregoing, the Examiner also asserts that “one cannot show nonobviousness by attacking piecemeal where the rejections are based on combinations of references.” While Applicant acknowledges that the rejection of claims 1-11, 13-21, 23-34, 36, and 37 was made pursuant to the combination of *Cupps* in view of *Hanson* and *Harrington*, Applicant respectfully submits that the cited references, either in combination or individually, do not disclose, teach, or otherwise suggest each and every element of Applicant’s claims. Applicant further submits that, *far from attacking the references “piecemeal,” Applicant has simply addressed each of the references comprising the combination with respect to the teachings that the Examiner has alleged that the references contain.* Applicant further respectfully submits that *if a claim element is not disclosed in any of the cited references individually, then surely the combination cannot teach what is not present in any of the individual references.* Accordingly, Applicant respectfully submits that independent claims 1, 13, 23, and 24 contain novel elements that are not taught, suggested or even hinted at by the proposed Cupps-Hanson-Harrington combination. It is well settled that, in an obviousness analysis, the prior art must disclose **each and every element of the claimed invention**, and that any motivation to combine or modify the prior art *must be based upon a suggestion in the prior art.* *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added).

Accordingly, since the proposed combination of Cupps-Hanson-Harrington, alone *and* in combination, fails to must “disclose each and every element” of independent claims 1, 13, 23, and 24, the proposed Cupps-Hanson-Harrington combination simply does not render obvious these claims. Therefore, for at least this reason, Applicant respectfully submits that the proposed Cupps-Hanson-Harrington combination fails to make obvious independent claims 1, 13, 23, and 24 of the subject application.

In addition to the foregoing, the Examiner has apparently taken Official Notice by asserting somehow that “**an ‘unusual delay’ constitutes real time.**” (30 June 2008 Final Office Action, Page 4) (Emphasis added). Significantly, the Examiner has set forth absolutely no evidence or reasoning tending to support this unfounded contention. Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, *it is inappropriate for the Examiner to take Official Notice without providing documentary evidence to support the Examiner’s conclusion.* (See MPEP § 2144.03). Applicant respectfully requests that the Examiner produce authority for the Examiner’s purported Official Notice.

It is well settled that, only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘*capable of such instant and unquestionable demonstration as to defy the dispute*’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis added). As the court held in *Zurko*, an

assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). Accordingly, Applicant respectfully submits that the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Applicant further submits that Applicant have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Applicant’s claims based on the Examiner’s Official Notice, Applicant respectfully requests that the Examiner provide documentary

evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge Applicant further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

Compounding the fact that the Examiner has put forth no evidence or reasoning to support the foregoing apparent Official Notice is the fact that the “unusual delay” disclosed in Hanson relates to “advis[ing] the order entry station if an unusual delay in future deliveries is to be expected, *so that customers can be advised accordingly.*” (Hanson Specification, Column 16, Lines 64-68). Once again, the Examiner has apparently completely ignored the fact that independent claims 1, 13, 23 and 24 *require* a “*comparison*” of “the requested particular food item with the real time availability information,” (Claims 1, 13, 23 and 24; and Specification page 7, lines 11-13), a comparison that is simply not disclosed *anywhere* in the proposed Cupps-Hanson-Harrington combination. Therefore, once again, missing from the proposed Cupps-Hanson-Harrington combination (either alone or in combination) is a critical element from Applicant’s independent claims 1, 13, 23 and 24. Thus, since the proposed Cupps-Hanson-Harrington combination clearly does not disclose, teach or even hint at independent claim 1, 13, 23 and 24 limitations relating at least to “a comparison of the requested particular food item with the real time availability information,” the proposed combination fails to render obvious these claims.

The Examiner has further asserted that “it would have been obvious to communicate the unusual delay as an estimated specific time because the estimated delivery time would equate to a specific time by knowing the time it currently is and adding the estimated delivery time.” (30 June 2008 Final Office Action, Pages 4-5). In addition to the fact that the Examiner has apparently taken improper Official Notice with respect to the foregoing assertion, Applicant respectfully submits that the Examiner’s assertion fails to take into account the “*comparison*” that is required by independent claims 1, 13, 23, and 24. Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, *it is inappropriate for the Examiner to take Official Notice without providing documentary evidence to support the Examiner’s conclusion.* (See

MPEP § 2144.03). Applicant respectfully requests that the Examiner produce authority for the Examiner's purported Official Notice.

The Examiner further appears to equate advising customers of an "unusual delay" with "real time delivery time information" as recited in independent Claim 1. Applicant respectfully submits that merely providing information that there will be a delay beyond the normal expected delivery time does not constitute providing customers with real time delivery time information because it does not provide a specific time estimate in real time as to when they may expect their order to be delivered. Also, the fact that the "order entry station" is the point at which customer notification of an "unusual delay in future deliveries" occurs suggests this notification does not occur *prior to* customers' selection of a restaurant from a plurality of restaurants nor *prior to* placement of an order with the selected restaurant. Rather, this suggests that notification of an "unusual delay in future deliveries" occurs after the customer has already selected a particular restaurant and has placed an order therein. As a result, Applicant respectfully submits that *Hanson* does not teach the claimed limitation for which the Examiner has relied on this reference.

Notwithstanding the Examiner's taking of Official Notice, Applicant respectfully submits that independent claim 1, 13, 23 and 24 elements relating to "generate a list of one or more of the plurality of unaffiliated sellers for at least one of the requested particular food items *according to a comparison of the requested particular food item with the real-time availability information*" is *nowhere* disclosed in Cupps, Hanson, or Harrington individually, nor in their proposed combination. Thus, since the proposed combination, either individually or in combination, does not disclose, teach or otherwise suggest each and every claim element of independent claims 1, 13, 23 and 24, these claims are simply not rendered obvious by the proposed combination.

Applicant further respectfully submits that, just as Cupps and Hanson (both alone and in combination) fail to disclose a "*comparison* of the requested particular food item with the real time availability information," so does Harrington (both by itself, or in combination with Cupps and/or Hanson). Notwithstanding, in asserting that Harrington somehow discloses "a comparison with real-time delivery information" *the Examiner argues that "inherently, the delivery time would take into account the availability."* (30 June 2008 Final Office Action, Page 5) (emphasis added). Once again, the Examiner has apparently asserted Official Notice in asserting that "inherently, the

delivery time would take into account the availability.” Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, *it is inappropriate for the Examiner to take Official Notice without providing documentary evidence to support the Examiner’s conclusion.* (See MPEP § 2144.03). Applicant further respectfully requests that the Examiner produce authority for the Examiner’s purported Official Notice.

Applicant respectfully submits that there is simply no inherency in Harrington that “the delivery time would take into account the availability,” as the Examiner asserts. Moreover, Applicant respectfully submits that even if Harrington did somehow disclose “inherently, the delivery time would take into account the availability,” which Applicant does not admit, that there is simply no equivalence between independent claim 1, 13, 23, and 24 elements relating to “a comparison of the requested particular food item with the real-time availability information” and “inherently, the delivery time would take into account the availability.” Specifically, even if the “inherently, delivery time would take into account the availability” in Harrington, which Applicant does not admit, Harrington still fails to disclose “*a comparison* of the requested particular food item with the real-time availability information” as claimed in independent claims 1, 13, 23 and 24 of the subject application. While the Examiner appears to argue that Harrington discloses “the delivery time would take into account the availability,” such does not account for the fact in Harrington that no “comparison of the requested particular food item with the real-time availability information” takes place, as required by claims 1, 13, 23 and 24.

Therefore, based upon the foregoing, Applicant respectfully submits that the proposed Cupps-Hanson-Harrington combination fails to disclose each and every element of independent claims 1, 13, 23 and 24 of the subject application. Furthermore, with respect to dependent Claims 2-11, 14-21, 25-34, 36, and 37: Claims 2-11 depend from independent Claim 1; Claims 14-21 depend from independent Claim 13; and dependent Claims 25-34, and 36-37 depend from independent Claim 24 and are also considered patentably distinguishable over the proposed Cupps-Hanson-Harrington combination. Thus, dependent Claims 2-11, 14-21, 25-34, 36, and 37 are

considered to be in condition for allowance for at least the reason of depending from an allowable claim.

B. 35 U.S.C. § 103(a) over Cupps in view of Hanson in further view of Harrington in further view of Cotter

In rejecting Claims 12, 22, and 35 under 35 U.S.C. § 103(a) over Cupps in view of Hanson further in view of Harrington further in view of Cotter, the Examiner states:

Cotter is relied upon for the teaching that the selection of the seller may not necessarily be the closest one because of the real-time delivery. In other words, the real time it would take for delivery is a factor in determining the seller. Cotter is note relied upon for the ‘real-time’ based on actual deliveries because that is disclosed in Hanson.

Nevertheless neither Cotter nor Hanson, whether taken together or separately, disclose or suggest each and every element of Claims 12, 22, and 35. Claim 12 provides among other things:

wherein the *broker is further operable to select one of the plurality of listed sellers automatically according to at least the real-time delivery time information* for all of the plurality of listed unaffiliated sellers.

Despite the Examiner’s assertion to the contrary, Cotter simply does not teach a “broker is further operable to select one of the plurality of listed sellers automatically according to at least the real-time delivery time information.” In particular, while the Examiner asserts that “the real time it would take for delivery is a factor in determining the seller,” this assertion completely disregards the plain fact that Cotter fails to disclose “*a broker*” that is “*further operable to select one of the plurality of listed sellers automatically according to at least the real-time delivery time information*.” Put another way, while the Examiner asserts that Cotter may use real time as a “factor in determining the seller,” with which Applicant does not agree, it is clear that Cotter in no way discloses, teaches, or even hints at “*selecting] one of the plurality of listed sellers automatically according to at least the real-time delivery time information*” via “*a broker*” that is so “operable.” In short, neither Cotter, nor Cotter in combination with Cupps-Hanson-Harrington, disclose “a broker is further operable to select one of the plurality of listed sellers automatically according to at least the real-time delivery time information.” In addition to the foregoing, *Cotter*

describes local factors that are considered when determining which store is best able to respond to an incoming order. *Cotter* does not, however, teach the use of “*real-time delivery information*” in selecting from a “*plurality of listed unaffiliated sellers*” as recited in Applicant’s amended Claim 12.

The factors relied upon in *Cotter* are merely predictions based on historical data and are not actually determined from real-time data. For example, the use of traffic patterns, time of day, and road construction as factors in determining which store is best able to handle the order relies on past information about the flow of traffic, typical conditions at a certain time of day, and the assumption that road construction that began at some time in the past is still currently in progress. *Cotter* does not disclose or suggest that actual real-time data about current traffic flows or other conditions currently existing is collected and used in making a determination about which store the order will be sent to.

As discussed in detail above, Applicant respectfully submits that neither *Cupps*, *Hanson*, nor *Harrington* teach the elements that the Examiner relies on these references for. *Cotter* also does not provide the missing teachings. Because the references do not alone or in combination, describe each element of Claims 12, 22, and 35, Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

Accordingly, since the proposed combination (both alone and together) fail to disclose each and every element of Applicant’s claims, the proposed Cupps-Hanson-Harrington-Cotter combination fails to render obvious claim 12. In addition, Applicant respectfully submits that claim 12 is both independently patentable for the reasons set forth above, and is also patentable for at least its dependence from an allowable independent claim (claim 1).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination According to the UPSTO Examination Guidelines

In addressing Applicant’s argument that the Examiner has not set forth an adequate finding of facts to substantiate a *Prima Facie* case of obviousness under the guidelines set forth in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”), the Examiner has asserted that “the facts have

been found in that the references have been shown to teach all the elements of the claims.” As an initial matter, and as can be plainly seen from the foregoing, **the references have clearly been shown not to teach all the elements of the claims.**

Applicant respectfully submits that, notwithstanding the Examiner’s assertions, the 30 June 2008 Final Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cupps*, *Hanson*, *Harrington*, or *Cotter*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact* concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Significantly, while the Examiner has asserted that he has somehow provided “findings of fact,” the written record in this matter is utterly devoid of any findings of fact concerning the “state of the art and the teachings of the references applied.” As noted above, instead of providing these findings of fact, the Examiner

has instead relied on conclusory assertions regarding the teachings of the references, without setting forth any evidence or reasoning tending to substantiate the putative “findings.”

In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). Once again, the Examiner has not provided an explanation to support the obviousness rejections. In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Final Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Final Office Action has not provided *an indication of the level of ordinary skill*.

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after*

consideration of all the facts. (*Id.* and See 35 U.S.C. 103(a)). This has not been done with respect to the subject application.

In particular, with respect to the subject Application, the Final Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Cupps, Hanson, Harrington, Cotter, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Cupps, Hanson, Harrington, Cotter, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that ““[R]ejections on *obviousness cannot be sustained by mere conclusory statements;* instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”*” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Final Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Cupps and Hanson to render obvious Applicant's claimed invention* other than to state that:

rationale C is probably best applied because both Cupps and Hanson are similar devices in that they are delivery services and Hanson provides the known technique for improvement, the real time based on actual deliveries, which would similarly improve the service of Cupps by providing information to the consumer. (30 June 2008 Final Office Action, Page 6).

The Examiner's unsupported conclusory statement that "Hanson provides the known technique for improvement, the real time based on actual deliveries, which would similarly improve the service of Cupps by providing information to the consumer" not only fails to provide any articulation, let alone "clear articulation of the reasons why Applicant's claimed invention would have been obvious", but also fails to disclose independent claim 1, 13, 23, and 24 elements relating at least to "a comparison of the requested particular food item with the real-time availability information." Put another way, the Examiner has not only failed to show "why Applicant's claimed invention would have been obvious," but has also failed to show how the proposed combination discloses each and every element of Applicant's claims. In addition, the Examiner's unsupported conclusory statements fail to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Cupps, Hanson, Harrington, and Cotter*, **Applicant respectfully requests that the**

Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.

Applicant's Claims are Patentable over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination

As mentioned above, independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, and Cotter*.

With respect to dependent Claims 2-12, 14-22, 25-35, 36, and 37: Claims 2-12 depend from independent Claim 1; Claims 14-22, 36, and 37 depend from independent Claim 13; and Claims 25-35 depend from independent Claim 24. As mentioned above, each of independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Thus, dependent Claims 2-12, 14-22, 25-35, 36, and 37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-37 are not rendered obvious by the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Applicant further respectfully submits that Claims 1-37 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-37 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

2 September 2008
Date

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